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08/935,116 09/22/97 DEATON

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EXAMINER

TM02/0918

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ART UNIT

PAPER NUMBER

2162

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/935,116

Applicant(s)
David DEATON

Examiner
Stephen M. Gravini

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2162



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 28, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 18 20) ☐ Other: _____

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DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed February 21, 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and/or MPEP § 609 because no copy of the references cited were enclosed with the information disclosure statement, no date was designated for a reference, and/or a reference did not have a publication source. Examiner has considered the domestic and foreign references since both are readily accessible to the examiner. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing elements will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 101

2. Claims 33-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The independently claimed invention recites stored transaction data which does not produce a useful, concrete or tangible result under *In re Alappat*, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v Signature Financial Group*.

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Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). The recited stored transaction data does not perform a function which would result in a useful, concrete, or tangible result such that the inventor may be entitled to a patent. Examiner bases further art rejections on the assumption that the claims are statutorily permitted.

Claim Rejections - 35 USC § 102

3. Claims 8, 9, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Creekmore (4,109,238). Creekmore discloses a system comprising: a terminal **13** for entering unique customer identification codes from customer identification presented at the point-of-sale in a retail transaction; means **26 & 27** for allowing entry of customer transaction data (the disclosed slot **26** and side **27** of the input terminal allows entry of customer transaction data because a customer enters an identification card transaction data **25**); a processor **19** and a memory **20** responsive to said terminal and said means allowing entry for creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code; and circuitry **18 & 25** responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale during said individual customer's transaction at said retail establishment upon detection of a unique identification code of said individual customer, said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and said signal

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providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion. Creekmore inherently generates customer information response signal as a function of analysis by circuitry of the individual customer's transaction following the detection of said unique identification code of the individual customer since the teachings of Creekmore disclose customer recognition and analysis.

4. Claims 33-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldman et al. (Re 30,580). Goldman et al. discloses a customer database comprising: stored transaction data from prior point-of-sale transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer, said transaction data including dollar amount of purchases and time period or alternatively including total dollar amount of purchases purchased during a period of time associated with an identification of a customer. Please refer to column 5 of Goldman which shows a table that lists up to five stored transactions outputs displayed to a cashier who will inherently be at a point of sale for a transaction (cashiers are normally at a point of sale during transactions). Not only does the output store a plurality of individual customer's data but the dollar amount (i.e. worthless, habitually overdrawn, or valid) and current time period. Goldman et al. also discloses time period of a day of week (discussed in the first full paragraph of column 12) and number and frequency of transactions (discussed at column 5).

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Claim Rejections - 35 USC § 103

5. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creekmore in view of Off et al. (4,910,672). Creekmore discloses a method comprising entering into a point-of-sale terminal a unique identification code for a customer (please see column 3 lines 6-10 which teaches the equivalent entry of account information and personal code into a transaction processor as the claimed point-of-sale terminal customer unique identification code); entering into said terminal transaction data relating to the customer's shopping transaction (please see column 3 lines 19-45 which teaches the equivalent transaction processor 19 that performs the claimed terminal transaction data entry); generating and maintaining a database, including the step of correlating said transaction data with said unique identification code (please see column 3 lines 39-66 which teach the equivalent generating and maintaining steps throughout the check cashing master file 20). Creekmore discloses the claimed invention except for the step of responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, said response including information for effecting a targeted promotion to the customer. Off et al. discloses that it is known to provide the step of responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the

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customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, said response including information for effecting a targeted promotion to the customer, as set forth at column 9, lines 15-60 (the input data at a scanner including a keyboard generates a coupon which inherently performs the claimed step of responding to entry in the same manner with the same function with the same results). It would have been an obvious to one skilled in the art, at the time the invention was made to modify the teachings of Creekmore, by providing the step of responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, said response including information for effecting a targeted promotion to the customer, as taught by Off et al. in order to allow a more effective marketing scheme to reward frequent shoppers with targeted promotions.

6. Claims 10, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creekmore in view of Off et al. in further view of Tai (4,908,761). Creekmore in view of Off et

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al. discloses the claimed invention, as discussed above, except for the response being related to the individual customer's transaction data in shopping visits prior to the current shopping visit. Tai discloses that it is known to provide the response being related to the individual customer's transaction data in shopping visits prior to the current shopping visit, as set forth at column 3, lines 18-50. It would have been an obvious to one skilled in the art, at the time the invention was made to modify the teachings of Creekmore in view of Off et al., by providing the response being related to the individual customer's transaction data in shopping visits prior to the current shopping visit, as taught by Tai in order to allow effective present time marketing by offering shoppers instantaneous promotional offers while actively shopping.

7. Claims 17-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creekmore in view of Off et al. in view of Tai in further view of Bigari. Creekmore in view of Off et al. in view of Tai discloses the claimed invention except for the dollar amount and time of purchase. Bigari discloses that it is known to provide a step of manipulating the dollar amount and time of purchase, as set forth at column 8, beginning with line 39. It would have been obvious to one skilled in the art, at the time the invention was made to modify the teachings of Creekmore in view of Off et al. in view of Tai, by providing a step of manipulating the dollar amount and time of purchase, as taught by Bigari in order to more effectively target consumers while shopping for promotional offers designed by marketing agencies.

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Double Patenting

8. Claims 8, 9, 12, and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent No. 5,305,196.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to add a terminal for a check transaction processing, database building and marketing method and system utilizing automatic check reading.

9. Claims 10, 11, and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 and 26 of U.S. Patent No. 5,201,010 in view of Tai. It would have been obvious to one skilled in the art to add the feature of a response being related to the individual customer's transaction data in shopping visits prior to the current shopping visit in order to allow effective present time marketing by offering shoppers instantaneous promotional offers while actively shopping.

10. Claims 15 and 16 are rejected under the judicially created doctrine of double patenting over claim 12 of U. S. Patent No. 5,659,469 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the entering steps, the generating and maintaining steps, and the responding steps.

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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

11. Claims 17-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 5,529,560. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art to claim broader subject matter than what is claimed in applicants' issued patent for an extension of patent rights.

12. Claims 33-39 are rejected under the judicially created doctrine of double patenting over claims 1, 2, and 3 of U. S. Patent No. 5,592,560 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the claimed dollar amount and purchase time.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application

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which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP § 804.

Response to Arguments

13. Applicant's arguments with respect to claims 8-39 have been considered but are moot in view of the new grounds of rejection. Examiner's answer to each argument in which rejections have been maintained are below.

non-statutory rejection of claims 33-39

Applicants argue that the amended claims clearly recite a useful, concrete, and tangible result. Examiner disagrees. The amended claims merely recite data without a machine or process. A machine or process would entitle applicants to a patent which would result in a useful, concrete, and tangible result.

manipulating the data
^

manipulating the data
^

anticipatory rejection of claims 8, 9, 12, & 13

Applicants argue that Creekmore's terminal is not at the point of sale as independently claimed. However at column 5, beginning at line 18, discusses "terminal 13 which may be positioned at any convenient point-of-use location such as a location near the checkout." This discussion shows the equivalency of applicants' terminal location to the teachings of Creekmore, because applicants' claimed terminal location at the point-of-sale is broad enough to encompass

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the terminal location as specifically taught in Creekmore (the expressed teaching of a terminal near the checkout is the same as applicants' terminal at the point of sale). Examiner disagrees with applicants' arguments because the terminal location is the same in both the independently claimed invention and in the prior art.

Applicants further argue that Creekmore does not allow entry of customer transaction data as independently claimed. At column 5 and 6 of Creekmore, customer data entry including inserting an identification card 25 into the terminal and a customer identification card 15 for "transaction information received at the input terminal" is discussed. Examiner disagrees with applicants' arguments because the independently claimed entry of customer transaction data is equivalent to the disclosed customer data entry such that in order to fulfill a transaction, a customer identification code must be entered.

anticipatory rejection of claims 33-39

The amendment of independent claims 33 and 34 render applicants' argument moot since claims 33-39 have been rejected under another prior art reference.

obviousness rejection of claims 15 & 16

Applicants argue a lack of motivation for combining the teachings of Creekmore with Off et al. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in

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a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The teaching of Creekmore incorporates the claimed features of correlating terminal transaction data with customer identification in a shopping transaction as discussed in the rejection above. In the same field of endeavor, Off et al. provides the missing independently claimed element for transaction analyzation for response generation. Examiner considers the reconstruction of Creekmore and Off et al. to be proper in order conclude obviousness based on one of ordinary skill at the time the invention was made.

Applicants further argue that the combination of the prior art would not result in the independently claimed subject matter. As discussed in the anticipatory rejection of claims 8, 9, 12, & 13 paragraphs above, examiner considers that Creekmore discloses a unique identification code for a customer at a point-of-sale terminal. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the claimed data analyzation for coupon

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distribution is disclosed in Off et al. for the motivation discussed under that reference's summary of the invention, specifically where conditioned coupon printing and coupon triggering is discussed.

Applicants also argue that Off et al. does not include the use of a unique identification code for a customer. Examiner disagrees. The disclosed response return point with respect to file access requests, disclosed at columns 9 & 10, inherently meets the independently claimed unique identification code for each shopper because each shopper's transaction is unique as reported at the disclosed response return point. Examiner considers the independently claimed use of a unique identification code for a customer to be equivalent to the disclosed response return point taught in the prior art.

obviousness rejection of claims 10, 11, & 14

Applicants argue that Off et al. does not include the use of a unique identification code for a customer at the point of sale. Examiner disagrees. The disclosed response return point with respect to file access requests, disclosed at columns 9 & 10, inherently meets the independently claimed unique identification code for each shopper because each shopper's transaction is unique as reported at the disclosed response return point. Examiner considers the independently claimed use of a unique identification code for a customer to be equivalent to the disclosed response return point taught in the prior art.

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Applicants also argue neither Creekmore nor Off et al. teaches or suggests either (1) the step of creating a database or (2) the step of generation a customer information response as independently claimed and that Tai fails make up the deficiencies of Creekmore and Off et al. Examiner disagrees. Tai teaches consumer promotional response patterns at column 3 under the summary of the invention. This teaching is equivalent to the claimed response relation to individual customer transaction data in shopping visits prior to the current shopping visit. because coupon redemption directly measures response in customers subsequent shopping visits which is precisely what is claimed by the applicants.

obviousness rejection of claims 17-32

Applicants argue that Creekmore in view of Off et al. in view of Tai in further view of Bigari do not teach or suggest (1) the structure of a computer implemented system providing a signal at a point of sale depending upon a customers shopping history and comprising a terminal for entering, during a transaction, a unique customer identification or (2) a database storing transaction data from prior transactions for a plurality of customer, such that data regarding a customers prior transactions are stored in association with an identification of that customers. Examiner disagrees. Each of the key elements claimed in applicants' claims 10, 11, 14, 15, and 16 are essentially the same key elements as those recited in claims 17-32. Examiner considers the method claims 10, 11, 14, 15, and 16 to be coextensive and not patentably distinct from apparatus (method) claims 17-32. Since both sets of claims are coextensive, the same prior art can be used

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to obviate the method steps as well as the apparatus features. Examiner considers Creekmore in view of Off et al. in view of Tai in further view of Bigari to obviate the claimed invention as discussed above under obviousness rejection of claims 10, 11, & 14 and the rejection above.

Applicant further argues that Bigari fails to disclose the step of manipulating dollar amount and time of purchase. Examiner disagrees. Dollar amount and time directly correlate to “cash register,” “purchase finalization,” and “periodic intervals” since these terms disclosed in Bigari at column 8 will inherently manipulate dollar amount and time of purchase and are equivalent to the claimed invention. Examiner considers Bigari to teach the equivalent dollar amount and time of purchase.

double patent rejection of claims 8, 9, 12, & 13

Applicants argue that applicants' earlier patent does not include means or a terminal for entering customer transaction data at the point of sale in the retail establishment and does not have (1) a processor and a memory responsive to the apparatus for entering unique identification codes or (2) the terminal for entering customer transaction data for creating a database of a plurality of the retail establishment's customers' transaction data from prior shopping visits nor does it have circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point of sale during the individual customer's transaction. Examiner disagrees. The elements recited in the present application are obvious modifications to elements already patented by the applicants. The patented device, memory, and

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circuitry system elements are obvious variations of the (1) processor and a memory responsive to the apparatus for entering unique identification codes or (2) the terminal for entering customer transaction data fro creating a database of a plurality of the retail establishment's customers' transaction data from prior shopping visits nor does it have circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point of sale during the individual customer's transaction. Examiner considers the presently claimed invention contains features that are obvious variations of the patented claim system features and maintains the obviousness-type double patent rejection.

double patent rejection of claims 15 & 16

Applicants argue that their earlier patent does not recite the step of entering into a terminal data relating to customer shopping transaction. Examiner disagrees. The patented claim step of "entering a plurality of customers' unique identification codes at the point of sale in the retail establishment" is equivalent to the step of entering into the terminal data relating to the customer shopping transaction. Examiner considers the patented claim step and the application claim step to be equivalent and maintains the double patenting rejection of claim 15.

Applicants further argue that their earlier patent does not recite the step of generating and maintaining a database. Examiner disagrees. The patented claim step of "generating incentive signals for different individual customers, said incentive signals designating a sales promotion on a specific product item for a plurality of individual customer's transactions in prior shopping visits,

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said incentive signal also designating different values for a plurality of customers for said sales promotion on said specific products in dependence upon said value determination” is equivalent to the step of generating and maintaining a database. Examiner considers the patented claim step and the application claim step to be equivalent and maintains the double patenting rejection of claim 15.

Applicants also argue that their earlier patent does not recite the step of responding to entries, during a current transaction, of unique identification code for a customer analyzing transaction data of the customer. Examiner disagrees. The patented claim step of “dispensing a sales promotion on a specific product item to said customers, said sales promotion related to the product items detected in individual customers’s transactions in prior shopping visits and the value of said sales promotion on a specific product based on said value determination for said individual customer, such that different sales promotions can be delivered to customers with different purchase volumes and different product detection” is equivalent to the step of responding to entries, during a current transaction, of unique identification code for a customer analyzing transaction data of the customer. Examiner considers the patented claim step and the application claim step to be equivalent and maintains the double patenting rejection of claim 15.

Applicants finally argue that their earlier patent does not recite the step of entering into a point of sale terminal an account number from a payment instrument presented by a customer. Examiner disagrees. The patented claim step containing transaction data entry of “customers’ unique identification codes” is equivalent to the step of entering into a point of sale terminal an

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account number from a payment instrument presented by a customer because the broader patented claim encompasses the subject matter of the presently claimed payment step since both are inherently equivalent. Examiner considers the patented claim step and the application claim step to be equivalent and maintains the double patenting rejection of claim 16.

double patent rejection of claims 17-32

Applicants argue a functional difference between the terminal and circuitry of patented claim 1 and the terminal of application claim 17. Patented claim 1 recites “a terminal for entering selected indicia from identification presented by customers at a point-of-sale in order to generate a unique identification code for each customer,” while application claim 17 recites “a terminal, for entering, during a transaction, a unique customer identification.” Patented claim 1 also recites “circuitry responsive to said processor and said database for dispensing a sales promotion at the point-of-sale during a customer’s checkout to said customers who meet said predetermined infrequent product purchase history criteria, wherein said sales promotion is for a product previously infrequently purchased and is redeemable at a further visit such that said customers are incited to return to the retail establishment to purchase said previously infrequently purchased product in a further transaction,” while application claim also 17 recites “circuitry responsive to the entry of said unique customer identification at said terminal during said transaction for transmitting to said point-of-sale during said transaction a customer information response signal.” Examiner considers both sets of functions equivalent since both terminals allow customer

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identification data entry and both circuitries are responsive to unique customer identification data.

The terminals are equivalent because patented claim 17 allows unique identification customer codes terminal entry while application claim 1 allows unique customer identification terminal entry. Because the terminals are equivalent, the functions of both terminals are the same.

Similarly, the circuitry of claim 17 allows customer identification by responding to the customer's previous shopping history in relation to a present shopping visit while the circuitry of application claim 17 allows customer identification of a present shopping visit. Both identify a customer because under the patented claim, data from a customer's prior shopping history can not be compared to a present shopping visit unless the customer identification were entered. Inherently, both circuitry features are equivalent. Applicants further argue that the patented claim recites a reader and processor that is not recited in the application claim. It would be an inherent function to use a reader and processor in the application claim because the specification supports a reader and processor to perform the claimed functions and applicant has not recited steps or features contrary to the specified a reader and processor. Under the doctrine of equivalents, the essential objective inquiry is: "Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?" Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 41 USPQ2d 1865, 1875 (1997). In determining equivalence, "[a]n analysis of the role played by each element in the context of the specific patent claim will thus inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute plays a role substantially different from the claimed element." Using the

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objective Warner-Jenkinson Co. inquiry, examiner finds equivalent elements with respect to terminal function and the circuitry function. In summary, examiner considers patented claim 1 to encompass the subject matter contained in application claims 17-21. The terminal and circuitry of the patented claim is recited broadly enough to encompass the terminal and circuitry of the application claim. Examiner considers the subject matter of both claims equivalent and perform the same function as discussed above. Similarly, the method claim of application claim 22 is co-extensive to apparatus application claim 17 for the same reasons discussed, the apparatus claims 22-26 are also rejected under the judicially created doctrine of obviousness-type double patenting.

Applicants further argue that application claims 27-32 are patentably distinct from patented claims 1 and 3 for similar reasons argued with respect to claims 17-26. Examiner disagrees. The structure and steps in the patented claims are expressly and inherently equivalent to the application claims as discussed above. The patented claims are broad enough to encompass the subject matter presently claimed. Because the present claims have been patented by applicants, examiner maintains the rejection under the judicially created doctrine of obviousness-type double patenting.

double patent rejection of claims 33-39

Applicants argue that claims 33-39 are directed to different subject matter than of patented claims 1-3. Specifically applicants argue that claim 34 recites transaction data which includes the total dollar amount of purchases purchased during a time period associated with an identification of

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a customer. Patented claim 2 recites "number of products purchased by the customer in the retail establishment over a specified time interval" and patented claim 3 recites "dollar amount of the product previously purchased." Examiner considers the claims of the prior patent in making a double patenting rejection. Although applicants allege that the subject matter may be different, if each of the features of the claims are equivalent with the same function, examiner finds a double patenting rejection to be proper. Furthermore, examiner considers the patented claims to expressly recite the same subject matter as found in the prior patented claims. Because the examiner considers the claims in making a double patenting rejection, the rejection under the judicially created doctrine of obviousness-type double patenting is maintained. The rejection in question was made under *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) Please see MPEP § 804 for guidelines in examiner's use of this rejection.

14. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". **If applicant(s) chose to send information be e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02.


STEPHEN GRAVINI
PRIMARY EXAMINER

smg
September 11, 2001